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APR 27 2011

OFFICE OF PETITIONS

**NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203**

In re Application of	:	
Simone Marie Jeha et al.	:	DECISION REFUSING STATUS
Application No. 10/533,940	:	ON PETITION
Filed: December 29, 2006	:	
Attorney Docket No. PTB-4398-207	:	

This is a decision on the petitions filed April 6, 2011 which are being collectively being treated as (1) a request under 37 CFR 1.48(a) and (b) to amend the inventive entity by the re-inclusion of eleven co-inventors, the addition of three new co-inventors and the removal of three co-inventors and (2) a petition under 37 CFR 1.47(a) to accept this application notwithstanding the absence of the signature of a re-included inventor, which is properly treated as a petition under 37 CFR 1.183 requesting waiver of the requirement under 37 CFR 1.64 that all the originally signing inventors also execute the supplemental oath or declaration filed April 6, 2011.

The petition under 37 CFR 1.183 is **GRANTED**.

The petition under 37 CFR 1.48(b) is **HELD IN ABEYANCE**.

The petition under 37 CFR 1.48(a) is **DISMISSED**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §§1.47(a), 1.183 and 1.48(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration and a statement of lack of deceptive intent executed by the currently non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The co-inventors to be re-included are Kenyon, Yee, Primrose, Saada, Snow, Sapula, Crumblin, Trevor-Wilson, Lithgow, Virr and Richmond. The inventors to be added are Janiak, Kao and Bath. The inventors to be removed are Jeha, Murray and Payne.

If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors.

In those instances wherein a request under 37 CFR 1.48(a) and a petition under 37 CFR 1.47 have both been filed in an application, the Office of Petitions may first issue a decision on the request under 37 CFR 1.48(a) so as to determine the appropriate oath or declaration under 37 CFR 1.63 required for the petition under 37 CFR 1.47. In those situations where, as here, a previously signing inventor refuses to execute a supplemental oath or declaration under 37 CFR 1.64, waiver under 37 CFR 1.183 of the requirement for an additional signature would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more than one assignee giving its consent, the extent of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for signatures from each originally named inventor on the supplemental oath or declaration.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)).

The request under 37 CFR 1.48(a) lacks compliance with items (2) and (5). As to item (2), no statements have been provided for the re-included co-inventors. As to item (5), the statement under 37 CFR 3.73(b) does not recite the reel/frame numbers of the assignments or include copies of the assignment documents.

Since the petition under 37 CFR 1.48(a) cannot be granted at this time, the petition under 37 CFR 1.48(b) to remove co-inventors must be held in abeyance as granting it at this time would result in no inventors listed for the above identified application.

On very infrequent occasions, the requirements of 37 CFR 1.64 have been waived upon the filing of a request and the fee set forth in § 1.17(f) for a petition under 37 CFR 1.183 (along with the supplemental oath or declaration) to permit the acceptance of that supplemental oath or declaration signed by less than all the originally signing named inventors. Petitions under 37 CFR 1.47 are only applicable to the initial execution of an original oath or declaration by a given inventor and are not applicable to the reexecution of another or supplemental oath or declaration by that originally signing inventor. In such circumstances, the USPTO will consider a petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR

1.64 that each of the actual inventors execute the supplemental oath or declaration, particularly where assignee consent is given to the requested correction. Absent assignee consent, the petition under 37 CFR 1.183 requesting waiver of the reexecution of the oath or declaration will be evaluated as to whether the nonsigning inventor was actually given the opportunity to reexecute the oath or declaration, or whether the nonsigning inventor could not be reached. In essence, petitioner must show that the inability to again obtain the signature statement from originally signing inventor Sapula is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond his control. The petition under 37 CFR 1.183 is granted.


Further correspondence with respect to this matter should be addressed as follows:

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